

Remarks

In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

The non-final Office Action dated April 10, 2008, lists the following rejections: claims 1-10 and 13 stand rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter; claims 1-4, 10 and 12-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Suzuki (EP 1 046 983); claims 5-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki as applied to claim 1, and further in view of Faraboschi (U.S. Patent 5,930,508); and claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki as applied to claim 1, and further in view of Iwata *et al.* (U.S. Patent 6,275,921) and Topham (U.S. Patent Pub. 2001/0047466). Applicant further notes that claim 7 is objected to for a clerical error. Applicant respectfully traverses each of these rejections, and requests reconsideration and allowance of the claims in light of the arguments presented below.

The § 101 rejection of claims 1-10 and 13 is improper because the claims are clearly directed to statutory subject matter, including processing apparatuses, methods, and computer readable media. None of the claims fall into the excludable subject matter categories of abstract ideas, laws of nature or natural phenomena (which nevertheless are eligible for patent protection when the claim recites a practical application that transforms an article or physical object to a different state or thing or otherwise produces a useful, concrete and tangible result, as stated in M.P.E.P. § 2106(IV)(C)(2)). However, without acquiescence or disclaimer, Applicant submits that the present amendment renders the § 101 rejection moot. Reconsideration and withdrawal of the § 101 rejection is therefore requested.

With respect to the § 102(b) rejection of claims 1-4, 10 and 12-13, Applicant submits that the present amendment renders the rejection moot by incorporating some of the subject matter originally recited in claim 5 into independent claims 1 and 12. Such amendment is made for the purposes of expediting prosecution, and without acquiescence or disclaimer. Reconsideration and withdrawal of the § 102(b) rejection is therefore requested.

Due to the present amendment, the § 103(a) rejection of claims 5-7 will be treated as if applied to all pending claims. Applicant submits that this rejection is improper because the Suzuki and Faraboschi references are not properly combinable, and because the proposed combination does not disclose all the features recited in Applicant's claims. Applicant submits that the references are not properly combinable when the proposed modification undermines a stated purpose of the primary reference. *See*, M.P.E.P. § 2143.01 and *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Applicant submits that the proposed modification would undermine the stated purpose of the Suzuki reference to provide program compression "without assigning special bits to an instruction field." *See, e.g.*, Suzuki, paragraph 0017. As such, there is no valid reason for one of skill in the art modify Suzuki by including any "control information" allegedly disclosed by Faraboschi.

Applicant further submits that the Faraboschi reference fails to disclose all the claimed features that are undisputedly deficient in the Suzuki reference. In particular, the dispersal bits disclosed by the Faraboschi reference do not indicate both an allocation of instructions to respective functional units and a sequential order for execution, as claimed.

Moreover, Applicant submits that the Office Action provides insufficient information regarding how the compression scheme disclosed in the Faraboschi reference is to be implemented in the teachings of the Suzuki reference. For example, the Office Action does not specify what portions of Faraboschi should replace what portions of Suzuki, if any. Applicant submits that any articulable implementation of Faraboschi's dispersal bits in Suzuki would necessarily amount to an assigning of special bits to an instruction field, thereby undermining Suzuki's teachings, as discussed above. Furthermore, the Office Action provides no support for the assertion that modifying Suzuki using the compression techniques of Faraboschi would somehow result in more efficient execution of the compressed instructions. Such an assertion is a matter of opinion that is unsupported by any evidence in the record. Rather, Applicant submits that one of skill in the art would understand Suzuki to teach a compression scheme that avoids techniques such as taught by Faraboschi, and therefore would not expect to achieve efficiencies in the combination.

For at least these reasons, the § 103(a) rejection over Suzuki in view of Faraboschi is improper, and Applicant requests that the rejection be reconsidered and withdrawn.

The § 103(a) rejection of claims 8 and 9 is improper because the addition of the Iwata and Topham references provides nothing to overcome the underlying deficiencies of the proposed combination of Suzuki and Faraboschi as noted above. For at least this reason, Applicant requests that the § 103(a) rejection of claims 8 and 9 be reconsidered and withdrawn.

Applicant further submits that newly added claims 14-17 recite allowable subject matter. In particular, Applicant submits that the art of record does not teach the extraction of a third individual instruction from a third instruction word for incorporation into the new single instruction word, or the adding of control information for the third individual instruction in the new single instruction word, as recited in claims 14 and 15. Moreover, claims 16 and 17 recite steps for the method of claim 12 that are commensurate with some of the subject matter recited in claims 6 and 7, which are allowable for the reasons stated above.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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